

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Jari Pekka Hamalainen CONF. NO.: 3070
SERIAL NO.: 09/827,593 ART UNIT: 2439
FILING DATE: 04/06/2001 EXAMINER: Shaw, Yin Chen
TITLE: METHOD FOR INDICATING ENCIPHERING OF DATA
TRANSMISSION BETWEEN A MOBILE COMMUNICATION
NETWORK AND A MOBILE STATION

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

INTRODUCTION

In response to the Office action mailed August 3, 2010, Applicant requests review of the non-final rejection in the above-identified office action. This office action is in response to an Amendment filed December 4, 2009 with a Request for Continued Examination. This request is being filed with a Notice of Appeal.

REMARKS

A. The examiner has failed to establish a prima facie case of obviousness based on the combined teaching of Sasuta et al. (US Patent 5,502,767) in view of Talbot (U.S. Patent 4,555,805) and Rasmussen et al. (US 5,222,136, "Rasmussen") under 35 USC 103(a).

In particular Applicant submits that the Examiner has clearly erred in stating that the cited reference Sasuta discloses in column 3, line 60 to column 4, line 17 and Figure 1 the following limitation of claim 19: *"monitoring by a mobile station in the mobile communication network of network control signals received by the mobile station from the mobile communication network over an air interface to detect a*

cipher mode command message, the cipher mode command message configured to request the mobile station to start enciphering of user data"

Equivalent language is contained in independent claims 59, 82, 85, and 94.

Applicant submits that Sasuta fails to disclose this feature of claim 19 and therefore, the equivalent features of the other independent claims. More specifically, it should be noted that the "encryption indication" upon which the Examiner relies, relates to an information field provided on the control channel of Sasuta's system to indicate whether information on the control channel is being transmitted in secure or non-secure mode (see Sasuta, column 4, lines 4-11). It is clear from the cited paragraphs that the purpose of this indication is to indicate whether particular information transmitted on the control channel is encrypted or not. Thus, Sasuta's "encryption indication" does not perform the role of requesting a mobile station to **"....start enciphering of user data" (data that would be transmitted on a working channel in Sasuta)**, as required by the independent claims as amended.

Furthermore, referring to Figure 1 of Sasuta, no such indication is suggested on the working channel of Sasuta and, in fact Sasuta's entire disclosure assumes that communication on the working channel is performed in a secure or encrypted manner. Sasuta is completely silent concerning the manner in which enciphered communication on the working channel is started.

The Examiner acknowledges that Sasuta is silent with respect to other features of the independent claims and cites the reference Talbot to remedy this deficiency.

B. Applicant further submits that the Examiner has erred in stating that Talbot discloses the following feature of independent claim 19 (Equivalent language is contained in independent claims 59, 82, 85, and 94):

"indicating to a user of the mobile station that said enciphered mode of communication for user data is set on in the mobile communication network, using a cipher mode indicator provided in the mobile station"

Applicant submits that the passages from Talbot, cited by the Examiner, fail to disclose the above element of the independent claims. More specifically, the referenced passages of Talbot refer to tone signaling conducted between the calling and called parties during call establishment (column 11, line 59 to column 12, line), switching between signaling and output lines in a mobile station when a secure connection is established (column 8, lines 3 to 25) and determining that a called party has answered a call by detecting

the lifting of a handset (column 9, lines 39 to 50). The latter part of this passage (specifically, column 9, lines 43 to 48) refers to an alternative arrangement in which a terminal (21) in the telecommunications network may wait for a secure service request from a calling or called party, thereby allowing users to decide if they wish to accept higher billing expenses that may be associated with a secure mode of communication.

It should be noted that in Talbot the tone signaling used during call establishment is not routed through the secure voice module (SVM). This can be seen from both the base station and mobile station block diagrams presented in Figure 1, and is stated explicitly in the text between column 5, line 63 and column 6, line 2. As a result, the tone signaling to and from the base station passes directly to and from the terminal (21) in a conventional manner (column 5, lines 65 to 67). It is therefore the Applicant's view that the tone signaling that takes place during call setup would not be audible to the called or calling party. Such signaling therefore fails to teach the providing of an indication to a user as required by the claims, since the user would not be able hear it.

Furthermore, even if the tone signaling were audible to the calling or called party, the most the calling party would hear might possibly be a conventional "dialing tone" when picking up a handset to dial a number and a "ringing tone" when the call is connected to the correct called line. As is known from conventional telephone systems, neither of these signals provides any indication of whether an *"....enciphered mode of communication for user data is set on in the mobile communication network"*.

If a secure connection exists, so that the parties to the call can be billed for the added service, (column 11, line 67 to column 12, line 2 of Talbot), this fails to disclose or suggest that any indication of the additional cost would be provided to either one of the parties either immediately before or during a secure call. Again there is no indication as asserted by the Examiner.

If a calling or called party requests a secure call, the party would be aware of his / her decision to request a secure call, there is no need for an indication and Talbot, therefore, provides no teaching or suggestion that this decision to select a secure mode of communication would be indicated to either of the parties to the call *"....using a cipher mode indicator provided in the mobile station"*, as required by the independent claims.

Applicant submits that Talbot fails to remedy the deficiencies of Sasuta

C. Applicant further submits that the Examiner has erred in stating that Rasmussen discloses the following limitation of claim 19 (Equivalent language is contained in independent claims 59, 82, 85, and 94): *"indicating to a user of the mobile station that said enciphered mode of communication for user data is set on in the mobile communication network, using a cipher mode indicator provided in the mobile station"*.

Applicant submits that Rasmussen specifically teaches away from the presently claimed solution and, for this reason, would not be considered by the skilled person. More specifically, in the background section of his patent, Rasmussen teaches that providing separate security systems to protect each type of communication device (e.g. telephones, fax machines, and computers) in an office environment is unduly expensive (column 1, lines 65 to 67). As a solution to this problem, Rasmussen suggests coupling the various devices, that may require secure communications, to a single encrypted communication device (ECOM) that is responsible for conducting encrypted communications across an otherwise unciphered communication network with a corresponding ECOM at a remote location (see Figure 1 of Rasmussen and associated description). This clearly teaches away from integrating encryption and display functionalities in any one of the various devices, and would therefore also teach away from providing the claimed features in a mobile station.

Applicant further submits that Rasmussen's system is not capable of providing a solution to the problem identified in the present application because the ECOM units of Rasmussen conduct secure communications over a network that is essentially "open" or unsecured. Secure communications take place only between communicating ECOM units. Any visual indication provided relate to a status of communication between the ECOMs and does not teach or suggest to provide an indication that an *"enciphered mode of communication for user data is set on in the mobile communication network"*. The network in Rasmussen is not configured to provide network control signals as provided in the claimed subject matter. Thus, because Rasmussen's ECOM is essentially not a mobile station and the users of Rasmussen communication network know that the network itself can only provide unsecured communication, the skilled person would not be motivated to consult Rasmussen's teachings when seeking to find the solution described in the claims of this application.

Given the lack of disclosure of the claimed features in the teachings of Sasuta (no cipher mode command message, no indication to a user) and Talbot (no cipher mode command message, no indication to a user), and the fact that Rasmussen actually teaches away from the solution provided by the presently claimed invention and is incompatible with the problem to be solved, Applicant submits that the skilled person

would not make the combination suggested by the Examiner. There is no clear motivation to make the suggested association of teachings. Nevertheless, the teaching of Rasmussen, fails to remedy the deficiencies of the combined teaching of Sasuta and Talbot. Accordingly Applicant believes the current independent claims to be patentably distinct from the proposed combination of Sasuta, Talbot, and Rasmussen and respectfully requests reconsideration of the application. Therefore, the combination of Sasuta, Talbot and Rasmussen fails to render claims the claims under consideration obvious.

D. The Examiner has also erred in rejecting the dependent claims of this application based on the combined teaching of Sasuta, Talbot and Rasmussen in view of an assortment of references, including Billstrom et al. (US 5,590,133, Lewis et al. (US 6,192,255, "Lewis") under 35 USC 103(a).and Kniffin et al. (US 6,072,402, "Kniffin") under 35 USC 103(a).Serbetciouglu et al. (US 5,719,918, Kennedy et al. (EP 0680171A2. None of these references remedy the deficiencies of the primary combination as indicated in paragraphs A-C above. Accordingly, favorable reconsideration and allowance is respectfully requested.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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